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IN THE

Supreme Court of the United States

OCTOBER TERM, 1969

No. 445

STANDARD INDUSTRIES, INC., *Petitioner*

v.

TIGRETT INDUSTRIES, INC., ET AL.

On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

BRIEF FOR THE AMERICAN PATENT LAW ASSOCIATION AS AMICUS CURIAE

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PREFACE

The United States

To all to whom these Presents shall come. Greeting.

Whereas Samuel Hopkins of the City of Philadelphia and State of Pennsylvania hath discovered an Improvement, not known or used before such Discovery, in the making of Pot ash and Pearl ash by a new Apparatus and Process, that is to say, in the making of Pearl ash 1st by burning the raw Ashes in a Furnace, 2d by dissolving and boiling them when so burnt in Water, 3d by drawing off and settling the ley, and 4th by boiling the ley into Salts which then are the true Pearl ash, and also in the making of Pot ash by fluxing the Pearl ash so made as aforesaid, which Operation of burning the raw Ashes in a Furnace preparatory to their Dissolution and boiling in Water, is new, leaves little Residuum, and produces a much greater Quantity of Salt: These are therefore in pursuance of the Act intitled "An Act to promote the Progress of useful Arts" to grant to the said Samuel Hopkins, his Heirs, Administrators and Assigns, for the Term of fourteen Years, the sole and exclusive Right and Liberty of using and vending to others the said Discovery of burning the raw Ashes previous to their being dissolved and boiled in Water, according to the true Intent and Meaning of the Act aforesaid. In Testimony whereof I have caused these Letters to be made patent, and the Seal of the United States to be hereunto affixed. Given under my Hand at the City of New York this thirty first Day of July in the Year of our Lord one thousand seven hundred & Ninety.

G. Washington

City of New York July 31st 1790.

I do hereby certify that the foregoing Letters patent were delivered to me in pursuance of the Act, intitled "An Act to promote the Progress of useful Arts", that I have examined the same, and find them conformable to the said Act.

Edm: Randolph Attorney General for the United States.

Delivered to the within named Samuel Hopkins this fourth day August 1790.

Th: Jefferson

First United States Patent Grant
July 31, 1790

COMMENT

The above is a copy of the First United States Patent Issued July 1790 under the Patent Act of 1790, *Without Any Claims*, over the Signatures of President George Washington, Secretary of State Thomas Jefferson, and Attorney General Edmund Randolph.

U. S. patent claim practice did not begin until after passage of the Patent Act of *1836*, as explained in Part VI-C of this Brief.

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BRIEF FOR THE AMERICAN PATENT LAW ASSOCIATION AS AMICUS CURIAE

I. AUTHORITY TO FILE

This amicus brief is presented to the Court under Rule 42. The letters of consent from petitioner and respondent are on file with the Clerk of the Court.

II. PURPOSE OF THIS BRIEF

This brief is filed by the American Patent Law Association ("APLA") as *amicus curiae* to show that this Court should reject the proposals regarding the patent law "doctrine of equivalents" set forth in the Brief for United States as Amicus Curiae". Available information indicates that such brief was prepared by the Antitrust Division ("AD") of the United States Department of Justice (and it is hereinafter called the AD brief for convenient reference).[1, 2]

Specifically, this *amicus curiae* brief has been filed by APLA to assist the Court by showing that the proposals made in the AD brief are not only without merit, but would prevent proper functioning of the U.S. patent system and frustrate achievement of its goals.

III. INTRODUCTION

The AD brief urges this Court to reject and now forbid the judicial application of the long-standing doctrine of equivalents for determining patent infringement, especially as explicated by this Court in the 1950 *Graver Tank* case.[3]

The *Graver Tank*, *Sanitary Refrigerator*,[4] and similar decisions of this and lower federal courts have

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[1] The APLA accepts as accurate the statements on page 1 of the AD brief regarding the opinions below and jurisdiction of this Court.

[2] The APLA takes no position in support of either petitioner or respondent.

[3] *Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*, 339 U.S. 605 (1950).

[4] *Sanitary Refrigerator Co.* v. *Winters*, 280 U.S. 30 (1929). That *Graver Tank* of 1950 is based on *Sanitary Refrigerator* of 1929, and even earlier cases of this Court, is recognized in the AD brief, page 11.

applied the doctrine of equivalents to determine patent infringement under the same statutory provisions for patent claims throughout the past 100 years.[5] However, the AD brief contends that this Court should now reject the doctrine of equivalents and substitute a new "fundamentally revised" standard[6] for determining patent infringement by limiting patent claims to their literal terms.

This brief will show that the propositions urged in the AD brief should be rejected by this Court because: (1) The positions stated in the AD brief are historically incorrect, legally without merit, and so unsound that their acceptance by this Court would seriously distort and undermine the statutory patent schemes established by Congress under the Patent Act of 1952; (2) Besides being unsound, the AD brief is nothing less than a request that this Court judicially legislate the end of long-standing sound and equitable patent infringement law and substitute a new test of patent infringement contrary to Congressional action in enactment of the Patent Act of 1952, whereas the Constitution delegates to Congress the power to alter the U.S. patent system and patent rights granted thereunder.

IV. THE APLA AS A FRIEND OF THE COURT IN THE PUBLIC INTEREST

The American Patent Law Association is an association of approximately 3800 members of the bars of many states interested in the laws relating to patents and allied subjects, including antitrust. This number

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[5] The patent claim provision carried into R.S. 4888 from Section 26 of the Patent Act of 1870 was readopted and codified in the Patent Act of 1952, Section 112, paragraph 2 (35 U.S.C. § 112, 2d par. (1952)), as amplified in Part VI-C hereafter.

[6] See AD brief, statement of "Questions Presented", at page 2.

represents over one-half of the patent lawyers in the entire country. The members are not restricted to any segment of the profession. Thus, members include both attorneys in the private practice of law and those employed by corporations and government. The members represent individuals, small and large research and development organizations, and large industrial and business enterprises.

The members are not only concerned with the obtaining of patents, but also with defending against patents, e.g., by avoiding infringement or proving patents invalid.

Significantly, the APLA membership as a whole represents widely divergent interests and views of (1) patentees and (2) their competitors, both of whom must determine the boundary between (a) activities covered by patent claims resulting in infringement liability and (b) activities outside the scope of patent claims which avoid infringement liability.

Since the members of the association never know which side of the issues involved in this case they will ultimately be on when representing the specific interests of their clients, the association believes it can speak fairly as to how the issue discussed in this brief affects the public interest, and help this Court recognize what the law has been on this issue and ought to be in the future.

In brief, the day-to-day and year-after-year experience of the 3800 APLA members and their principals provides enormous cumulative knowledge and experience for evaluating the merits or shortcomings of particular aspects of the United States patent system. Thus, it is believed that the APLA views may help

this Court in evaluating the legal, practical and social effects which the AD brief proposal is likely to have on the technical, economic-competitive and social goals of the federal patent system under the statutory scheme established by Congress in the Patent Act of 1952, effects which APLA considers adverse.

V. SUMMARY OF ISSUES AND POINTS

In this brief *amicus curiae*, the APLA will discuss the following points with reference to the AD brief:

1. The test proposed in the AD brief, as a substitute for existing law, is in language so vague that no useful purpose could flow from its adoption. As revealed, however, by the AD suggestions for application of this "new" test in this case, it is apparent that the intent of the proposed test is to substitute literalism for equity.

2. The doctrine of equivalents as explicited in the 1950 *Graver Tank* and 1929 *Sanitary Refrigerator* cases plus other decisions of this and lower federal courts is in fact consistent with the statutory patent scheme reaffirmed by Congress in the Patent Act of 1952. That doctrine does NOT conflict with or subvert the policy of the federal patent system as established by Congress under the Constitution; rather it is an integral part of the system under the Patent Act of 1952.

3. Legislative history of the Patent Act of 1952 shows that in enacting Section 112 and 271 (a) thereof Congress legislatively ratified and codified the then-prevailing law of "direct" patent infringement, including the doctrine of equivalents as explicated in the *Graver Tank* case which was decided in 1950 at the

very time Congress was actively working on the Patent Act of 1952.

4. This Court can and should decide the instant case under long-standing law of patent infringement including the sound and equitable doctrine of equivalents, which prevailed under the Patent Act of 1870, was legislatively ratified in the Patent Act of 1952, and has been well defined by the courts and is now understood by patentees, industry at large, and the Patent Office.

5. This Court should reject the AD brief's proposal that the Court now reject the doctrine of equivalents and judicially legislate a test of patent infringement based on literal interpretation of claim language subject to "colorable or trival deviation[s]",[7] because that proposed test of infringement will be unworkable and inequitable. That test of infringement would reduce the U.S. patent system to a game of semantics thereby subverting Congressional patent policy and the statutory patent scheme so as to frustrate the Constitutional purpose of the patent system.

6. Judicial rejection of the doctrine of equivalents and adoption of the AD brief proposals will substantially affect the scope of the claims of the more than 850,000 presently unexpired U.S. patents,[8] all of which were issued under the Patent Act of 1952 and the premise that the *Graver Tank* rule was governing law.

7. This Court also should reject the AD brief seeking judicial reversal of long-standing law because since

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[7] See AD brief at bottom of page 16.

[8] This stated number of affected unexpired patents is based on the U.S. Patent Office "Official Gazette" of January 20, 1970.

1967 Congress has been and is now considering in depth a complete recodification of the U.S. patent law as instigated by studies and recommendations of the "President's Commission on the Patent System" appointed in 1965.[9] This Court should instruct the Antitrust Division that Congress is the proper body for making such broad changes as rejection of the doctrine of equivalents and adoption of a new "fundamentally revised" test of patent infringement.

VI. STATEMENT AND ARGUMENT

A. THE CONSTITUTIONAL PROVISION FOR A U. S. PATENT SYSTEM REFUTES THE ANTITRUST DIVISION BRIEF

Following are *all* provisions of the Constitution pertaining to patents and to the issues before the Court:

> Article I.
>
> Section 1. *All* legislative Powers herein granted shall be vested in a Congress of the United States . . .
>
> Section 8. The Congress shall have Power . . .
>
> To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries;[10]
>
> . . . And
>
> To make *all* Laws which shall be necessary and proper for carrying into Execution the foregoing Powers, and all other Powers vested by this Constitution in the Government of the United States,

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[9] See *Graham* v. *John Deere Co.*, 383 U.S. 1, 19 (1966) and particularly this Court's footnote 10.

[10] See *Graham* v. *John Deere Co.*, *supra*, 383 U.S. at 5-6 (1966), particularly this Court's footnote 1.

> or in any Department or Officer thereof. [Emphasis added.] [11]

The above-quoted sections of the Constitution pertaining to patents show clearly that the Constitution itself lends no support whatever to the purported Constitutional and related arguments in the AD brief, such as the following:

> "The Patent Clause of the Constitution . . . carefully restrict[s] the scope of the patent monopolies and the method by which they may be achieved . . ." (brief, page 5)

> ". . . the doctrine of equivalents, as presently interpreted, subverts the federal patent policy defined by the Constitution . . ." (brief, page 6)

> "The doctrine of equivalents permits a patent owner to enforce monopoly power . . . . Even though not expressly within the scope of the claims of his patent . . . . [and] this result is contrary to the balance achieved in the Constitution . . ." (brief, page 2)

The Constitutional provisions, decisions of this Court *ab initio*, and the Congressional history of five comprehensive statutory patent schemes established by Congress in the major Patent Acts of 1790, 1793, 1836, 1870 and 1952, refute the AD brief's reliance on the Constitution for its proposals that this Court judicially legislate out of existence the doctrine of equivalents and substitute a new "fundamentally revised" standard for patent infringement.

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[11] U.S. CONST., Art. I, § 8.

B. THE CONGRESS HAS COMPLETE POWER TO LEGISLATE THE FEDERAL PATENT SCHEME AND SCOPE OF PATENT RIGHTS UNDER THE CONSTITUTION

"[The] powers of Congress to legislate upon the subject of patents is *plenary* by the terms of the Constitution . . ." *McClurg* v. *Kingsland,* 1 How. 202, 206, 42 U.S. 202, 206 (1843). (Emphasis added.)

"Congress of the United States [is] the source of all rights under patents," including the delineating of the enforceable scope of U.S. patents and their claims in relation to the antitrust laws under the Sherman Act of 1890 and the Clayton Act of 1914. *Motion Picture Patents Co.* v. *Universal Film Mfg. Co.,* 243 U.S. 502, 517 (1917).

As recently as 1966, in *Graham* v. *Deere, supra,* this Court reiterated that:

> "Congress may, of course, implement the stated purposes of the Framers [of the Constitution] by selecting the policy which in its judgment best effectuates the constitutional aim. This is but a corollary to the grant to Congress of any Article I power. *Gibbons* v. *Ogden,* 9 Wheat 1 . . . *McClurg* v. *Kingsland,* 1 How. 202, 206. It is the duty of the Commissioner of Patents and of the courts in the administration of the patent system to give effect to . . . the statutory scheme of the Congress." [12]

C. THE FIVE MAJOR U. S. PATENT ACTS PASSED BY CONGRESS BETWEEN 1790 AND 1952 REFUTE THE ANTITRUST DIVISION BRIEF

Beginning one year after ratification of the Constitution, Congress has passed five major patent acts comprehensively dealing with the statutory patent scheme;

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[12] See 383 U.S. at 6.

namely, the Patent Acts of 1790, 1793, 1836, 1870 and 1952.[13, 14]

In addition, Congress has amended the five major U.S. Patent Acts at least fifty times.[15]

An objective review of the five comprehensive Patent Acts of 1790, 1793, 1836, 1870 and 1952 shows that Congress has at different times established various substantially different types of statutory schemes for determining the valid enforceable scope of the "exclusive right" granted to inventors, under Article I, Section 8 of the Constitution.

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[13] See House and Senate Reports on Patent Act of 1952, H.R. Rep. No. 1923, 82d Cong., 2d Sess., pp. 3-4 (1952), and S. Rep. No. 1979, 82d Cong., 2d Sess., pp. 2-3 (1952).

[14] Also see "Commentary on the New [1952] Patent Act" by P.J. Federico, Examiner-in-Chief, U.S. Patent Office, 35 U.S.C.A. Vol. 1 (1954) (hereafter called the "Federico Commentary on the 1952 Act"), pages 2-6. As noted in the House and Senate Reports on the Patent Act of 1952, cited fn. 13 *supra*, Mr. P.J. Federico, as Examiner-in-Chief of the U.S. Patent Office, and then patent lawyer Giles S. Rich, who is now an Associate Judge of the U.S. Court of Customs and Patent Appeals, were two of the principal experts assisting Congress in the drafting, refinement and adoption of the Patent Act of 1952. The roles of Examiner-in-Chief Federico and Judge Rich in Congressional consideration, drafting and passage of the Patent Act of 1952 have been recognized by this and other courts, as well as Congress. For example, as to Judge Rich, see the *"Aro I"* case [365 U.S. 336 (1961)], and the *"Aro II"* case [377 U.S. 476 (1964)], both of which are more fully cited and discussed, *infra*. As to Examiner-in-Chief Federico and his "Commentary", see *Southern Saw Service, Inc.* v. *Pittsburgh-Erie Saw Corp.*, 239 F. 2d 339, 342 (5th Cir. 1956). For further background, see "Congressional Intent—Or Who Wrote the Patent Act of 1952?" by Giles S. Rich, PATENT PROCUREMENT AND EXPLOITATION, BNA (1963) (hereafter called "Rich, Patent Act of 1952").

[15] *Graham* v. *Deere*, *supra*, refers to at least fifty such amendments, 383 U.S. at 10; "Federico Commentary on the 1952 Act", *supra*, refers to at least sixty such amendments, 35 U.S.C.A., Vol. 1, page 5.

Historical review and statutory analysis particularly show that: (1) The Patent Acts of 1790 and 1793, passed one and three years after ratification of the Constitution, provided for issuance of patents *without any claims;* (2) U.S. patent claim practice such as now in issue before this Court did not begin until after adoption of the Patent Act of 1836; and (3) patent claims as such are clearly not a Constitutional requirement.

More specifically, historical and legal analysis of the five comprehensive Patent Acts of 1790, 1793, 1836, 1870 and 1952 shows the following statutory schemes for determining patent scope *without and with* claims.

1. First U.S. Patent Act of 1790: No Patent Claims Were Involved

The first comprehensive Patent Act of 1790 was enacted by the very first U.S. Congress upon recommendation of President George Washington, who was also President of the Constitutional Convention. The 1790 Act was administered by the first "Patent Commission" of three members, including Thomas Jefferson, who was the Commission's moving spirit and effectively the "First Administrator" of the U.S. patent system under the 1970 Act.[16]

The Patent Act of 1790 included *no* provisions for any claims in the patents granted thereunder. As a matter of interest, this Court is respectfully referred to the preface of this brief which is a copy of the first United States patent issued July 31, 1790 under the Patent Act of 1790 over the signature of President George Washington, Secretary of State Thomas Jeffer-

[16] *Graham* v. *Deere, supra,* 383 U.S. at 6-7.

son, and Attorney General Edmund Randolph. The Court will note that the patent contains no claims such as involved in the instant case.

2. Second U.S. Patent Act of 1793: No Patent Claims Were Involved

Thomas Jefferson was not only "First Administrator" of the patent system under the first 1790 Act, but he was also the author of the second U.S. Patent Act of 1793.[17]

The Patent Act of 1793 made the granting of U.S. patents a clerical function. Under the 1793 Act, patents were routinely granted to anyone who applied and fulfilled the formal requirements of filing papers and paying fees.[18] The 1793 Act did *not* involve any patent claims such as now in issue before this Court.

Thus, from 1793 until 1836, under the Patent Act of 1793 drafted by Jefferson, Congress exercised its broad patent powers under the Constitution and established a *registration* patent system which (1) did not require examination on the merits for issuance of U.S. patents and (2) did not require *any* patent claims.

3. Third U.S. Patent Act of 1836: Patent Claim Practice Began

The 1793 Patent Act was replaced in 1836 by a third comprehensive statutory scheme when Congress enacted the Patent Act of 1836. The 1836 Patent Act first established a Patent Office having the function of

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[17] *Graham* v. *Deere*, *supra*, 383 U.S. at 7.

[18] See the House and Senate Reports on the Patent Act of 1952 cited in fn. 13, *supra*; especially H.R. Rep. No. 1923, page 4 and S. Rep. No. 1979, page 3. See also "Federico Commentary on the 1952 Act", *supra*, 35 U.S.C.A., Vol. 1, page 4.

examining applications for and issuing or refusing patents.[19]

Section 6 of the 1836 Act described the requisite contents of a patent application, specifically requiring that the applicant "*shall particularly specify and point out* the part, improvement, or combination, *which he claims* as his own invention or discovery."[20] Many examples of claims from patents granted under this Act appear in reported decisions of this Court.[21]

As pointed out by this Court in *Graver Tank*, the doctrine of equivalents was first enunciated in a case involving infringement of a patent granted under the Act of 1836; *Winans* v. *Denmead*.[22] In *Winans*, the Court was concerned with the precise question of the scope of the claimed invention.[23] The dissenting opinion in *Winans* quoted[24] from the above-cited statutory language of the Act of 1836 relating to patent claims and argued for a rule of interpretation which is strikingly similar to that now proposed by the AD brief. However, the majority of the Court in *Winans* took a different view of the statutory requirement for patent claims and held, in essence, that substance should take precedence over form when construing the language of the Act.

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[19] Ibid, especially H.R. Rep. 1923, pages 4-5 and S. Rep. No. 1979, pages 3-4; also "Federico Commentary on the 1952 Act", page 4.

[20] 5 Stat. 117 (1836) (Emphasis added.)

[21] See, e.g. *Seymour* v. *Osborne*, 78 U.S. 516 (1870); *Burr* v. *Duryea*, 68 U.S. 531 (1863).

[22] 56 U.S. 330 (1853).

[23] Id. at 342.

[24] Id. at 347.

The law and practice of U.S. patent claims for determining the valid scope of patents and infringement thereof evolved under the 1836 Act until Congress passed the fourth comprehensive U.S. Patent Act of 1870. The 1870 Patent Act included a section (which became known as "R.S. 4888") which contained statutory provisions on patent claims that effectively adopted and carried forward claims practice as it existed when the 1870 Act was enacted upon recommendations of a special Patent Commission.[25] In turn, R.S. 4888 of 1870 was readopted in the 1952 Act as the current statutory provision on claims[26] as amplified below.

Thus, the AD brief errs in stating the 1853 *Winans* decision is based on a "significantly different statutory scheme"[27] for patent claim practice as compared to that involved in *Graver Tank* and this case.

4. Fourth U.S. Patent Act of 1870: Current U.S. Patent Claim Practice Is Based on the 100-Year-Old Statutory Patent Claim Provision of R.S. 4888 (Section 26 of the 1870 Act) Which Was Applied in the 1950 Graver Tank and 1929 Sanitary Refrigerator Cases and Was Readopted in Section 112 of the 1952 Patent Act

The Patent Act of 1870 was the fourth comprehensive patent statute and contained the following language relating to the patent specification and claims:

> "Section 26 . . . before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in

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[25] See "Federico Commentary on 1952 Act", fn. 14, p. 5; also compare above-quoted portion of Section 6 of the 1836 Act with R.S. 4888, quoted at page 15, *infra*.

[26] 35 U.S.C. § 112, par. 2 (1952).

[27] AD Brief, p. 12.

> writing, to the commissioner, and shall file in the Patent Office a written description of the same . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains . . . to make, construct, compound, and use the same; . . . *and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery;* . . ." (Emphasis added.)[28]

This Court's decisions in the 1950 *Graver Tank* and 1929 *Sanitary Refrigerator* cases specifically involved construction and application of R.S. 4888 to determine the question of patent infringement.

The majority opinion in *Graver Tank* applied the doctrine of equivalents as therein explicated, citing *Sanitary Refrigerator* of 1929 and other earlier cases of this Court which applied the doctrine of equivalents under R.S. 4888 to construe patent claims and determine patent infringement.[29] The 1950 *Graver Tank* case rejected a minority opinion of two Justices which contended in detail that the patent claims provision of R.S. 4888 requires literal construction of the patent claim language and precludes application of the doctrine of equivalents to determine patent infringement.

In fact, it is clear that the AD brief presents substantially the same theories and contentions of the minority opinion of two Justices in *Graver Tank;* and it is clear the majority opinion of this Court fully considered and rejected the same in 1950. We respect-

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[28] This is verbatim the pertinent text of R.S. 4888, 35 U.S.C. 33 (1946 ed.) in force in 1952.

[29] In *Graver Tank, supra,* see especially 339 U.S. at 608-09.

fully urge that this Court should reject these proposals in the AD brief and decline judicially to eliminate the doctrine of equivalents as it was reiterated in the 1950 *Graver Tank* majority decision expressly rejecting the minority contentions for a restrictive rule such as now urged by the AD brief.

This Court's reversal now of long-standing patent infringement law as sought in the AD brief would be particularly unwarranted because the legislative history of the 1952 Patent Act shows Congressional intent to legislatively ratify and codify the then prevailing law of "direct" patent infringement, including the long-standing doctrine of equivalents as explicated in *Graver Tank*.

5. Fifth U.S. Patent Act of 1952: Congress (a) Readopted Patent Claims Statute R.S. 4888 and (b) Legislatively Ratified and Codified the Law of "Direct Infringement" (Including Graver Tank), in 35 U.S.C. § 112 (2d Par.) and § 271(a)

(a) The Present 1952 Patent Act Readopted the 1870 Statutory Provisions on Patent Claims

In about 1948, the Congress began a comprehensive review of the U.S. patent laws which resulted in enactment of the Patent Act of 1952.[30]

By the 1952 Patent Act, Congress established the current statutory patent scheme which governs the instant case.

The statutory provisions relating to patent claims from former R.S. 4888 (1870 Patent Act) are set forth in the second paragraph of section 112 of the 1952

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[30] See House and Senate Reports on 1952 Act, cited in fn. 13, *supra*. See also "Federico Commentary on 1952 Act", and "Rich, Patent Act of 1952", cited in fn. 14, *supra*.

Patent Act. This is clear from (a) comparison of the statutes and (b) express statements to that effect in the House and Senate Reports on the 1952 Patent Act.[31,32]

The aforesaid statutory patent claims provision in the 1952 Patent Act, section 112, par. 2, reads as follows:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." [33]

Thus, the legislative history of the 1952 Act shows that: (a) section 112 of the 1952 Act was drafted with separate paragraphs on specifications and claims in order to distinguish more clearly between them; and (b) the second paragraph of section 112 of the 1952 Act is directly based on the claims clause in former R.S. 4888 stating the statutory requisite that a U.S. patent include claims pointing out the invention.

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[31] Ibid. See particularly H.R. Rep. 1923, "Revision Notes", page 19, and comparison of prior and 1952 statutory text under "Ramseyer Rule," page 40, and Tables comparing prior and 1952 statutory texts, pages 70-72. See also "Federico Commentary on the 1952 Act", *supra*, 35 U.S.C.A., Vol. 1, (1954) pages 24-25.

[32] The provisions of prior R.S. 4888 relating to patent *specifications* are contained in the first paragraph of section 112 of the 1952 Patent Act. This is clear from (a) comparison of the statutes and (b) express statements to that effect in the House and Senate Reports on the 1952 Patent Act. See legislative history referred to in fn. 31, *supra;* also "Reviser's Note" in 35 U.S.C.A., Vol. 2, section 112, (1954).

[33] Note the text of par. 2 of section 112 of the 1952 Patent Act is substantially the same as the claims provision of the 1870 Patent Act, quoted at page 15, *supra*.

(b) The 1952 Patent Act Contains New Section 271(a) Codifying the Law of "Direct Infringement" (Including the 1950 "Graver Tank" Rules)

In 1952, when Congress reenacted as the second paragraph of 35 U.S.C. § 112[34] the patent claim provision of R.S. 4888, in language originated in 1870, Congress also enacted the first statutory provisions defining acts of patent infringement, namely in new section 271 entitled "Infringement of patent".[35]

The provisions of new section 271 enacted in 1952 as part of the current statutory patent scheme define: (1) "direct infringement" per section 271(a); (2) "inducement infringement" per section 271(b); and (3) "contributory infringement" per section 271(c).

New section 271(d) of the 1952 Act affirms the relief to which a patent owner is entitled under any of sections 271(a) to (c) without being guilty of "patent misuse" or other illegal extension of monopoly, thereby

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[34] The first paragraph of Section 112 deals with the requirements of *disclosure,* NOT *claims;* the third paragraph does relate to claim form and claim construction. It uses and approves the very word "equivalents" as an element of prescribed claim construction. This third paragraph was adopted, as testimony before the House made explicit, to offset "the much criticized theory of the Halliburton case" [*Halliburton Co.* v. *Walker*, 329 U.S. 1 (1946)]. The Department of Justice then [June 14, 1951] characterized section 112, 3rd par. to the Congress as "introducing into the statute for the first time the controversial doctrine of equivalents." See Hearings fully cited in fn. 38, *infra*, pp. 45 and 95.

[35] For legislative history and information on Congressional intent regarding new Section 271 of the 1952 Act, see House and Senate Reports on that cited fn. 13, *supra,* particularly H.R. Rep. 1923, p. 9, and S. Rep. 1979, p. 8; also "Federico Commentary on the 1952 Act", 35 U.S.C.A., (1954) Col. 1, pages 52-54; and "Reviser's Notes" on Section 271, 35 U.S.C.A., 1954 Ed., Col. 2, p. 18. In addition, see *Aro II,* 377 U.S. pp. 485-486 (1964) and fn. 6 therein referring to and relying on various legislative history of the 1952 Act including Congressional Hearings on section 271 (see Hearings fully cited in fn. 38, *infra*).

limiting certain pre-1952 Court decisions insofar as they are inconsistent with the statutory provisions of new sections 271(a) to (d).[36]

Significantly, enactment of § 271(c) defining contributory infringement and § 271(d) limiting the patent misuse doctrine of certain pre-1952 cases, as held in "*Aro II*", establishes that Congress does *not* contemplate an "iron-bound" rule that the language or semantics per se of patent claims shall control determination of "Infringement of patent" under the 1952 Act. On the contrary, this shows that Congress can and does establish Federal patent policy and statutory schemes whereby patent infringement liability is not limited to the literal terms of patent claims per se.

Section 271(a), which defines "direct" infringement, states that:

> ". . . whoever without authority makes, uses, or sells any *patented invention* . . . infringes the patent." (Emphasis added.)

In the 1952 Act, section 112, par. 2 contains the statutory provisions for patent claims which define what constitutes the "patented invention" to determine what "infringes the patent" under § 271(a). As shown earlier that paragraph of section 112 of the 1952 Act repeats the same claim provisions of R.S. 4888, which was the statute construed and applied in the 1950 *Graver Tank, Sanitary Refrigerator*, and other prior

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[36] *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 377 U.S. 476 (1964), particularly Part I thereof (herein called "*Aro II*" case, per fn. 14, *supra*). The "*Aro II*" case is a continuation of litigation in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 365 U.S. 336 (1961) (herein called the "*Aro I*" case, per fn. 14, *supra*).

patent infringement decisions of this Court applying the doctrine of equivalents.

In the *"Aro I"* and *"Aro II"* cases, *supra,* this Court recognized that Giles S. Rich, now Associate Judge of the U.S. Court of Customs and Patent Appeals, was a "chief draftsman" of Section 271 and the "spokesman" for proponents of that section in June 1951 "Congressional Hearings on the 1952 Patent Act."[37, 38] In those Congressional Hearings, Judge Rich stated with respect to new Section 271(a) that: (1) section 271(a) dealt with "direct infringement which is the making, using, or selling of the *patented invention* without permission"; and that (2) this new "infringement section . . . is a codification of the finest kind".[39]

The "Reviser's Notes" on Section 271 and the House and Senate Reports[40] are consistent with the foregoing statements. The Reports state that "Section 271, paragraph (a), is a declaration of what constitutes infringement".[41]

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[37] See *"Aro II"* case, 377 U.S. at 485-486 and fn. 6 therein; also *"Aro I"* case, 365 U.S. at 366.

[38] "Hearings Before Subcommittee No. 3 of the House Committee on the Judiciary, House of Representatives, 82d Cong. 1st Sess., on H.R. 3760, 'A Bill To Revise And Codify The Laws Relating To Patents And The Patent Office And To Enact Into Law Title 35 Of The United States Code, Entitled Patents'," June 1951, Serial No. 9 [herein called "Congressional Hearings on the 1952 Patent Act"].

[39] Ibid., p. 151. [Emphasis added.]

[40] See House and Senate Reports cited fn. 13, *supra,* H.R. Rep. 1923, p. 9, and S. Rep. 1979, p. 8.

[41] In contrast, however, the House and Senate Reports discuss in detail provisions of Sections 271(b), (c), and (d) intended to overrule inconsistent pre-1952 decisions relating to contributory infringement and patent misuse.

The June 1951 "Congressional Hearings on the Patent Act of 1952" and the July 1952 passage of that Act occurred only a short time after this Court's 1950 decision in the *Graver Tank* case. When the 1952 Act was passed, *Graver Tank* was this Court's leading decision on the law for determining patent infringement under the statutory claim provisions of R.S. 4888 readopted by Congress in 1952 (35 U.S.C. 112, 2d par.).

When Judge Rich stated in the June 1951 "Congressional Hearings" that Section 271(a) was a "codification" of the law on "direct infringement" and the "Reviser's Notes" and House and Senate Reports of July 1952 state that section 271(a) is "declaratory" of patent infringement, it is unreasonable to conclude that Congress did not take into account the leading 1952 *Graver Tank* case wherein this Court aptly re-articulated long-standing rules for determining patent infringement *including the doctrine of equivalents.*

The entire legislative history of the 1952 Patent Act shows that Congress intended to codify then prevailing patent law excepting where the statutory text and the legislative history indicate intent to revise prior statutory and/or case law.[42]

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[42] See House and Senate Reports cited in fn. 13, *supra;* especially H.R. Rep. 1923 on "History of Present Bill", p. 2-3 and on "General Description of Bill", p. 5, and S. Report 1979 on "Purpose" and "Statement", pp. 1 and 3. Also see "Federico Commentary on the 1952 Act", 35 U.S.C.A., Col. 1, pp. 6-9, and "Rich Article on 1952 Act", cited fn. 14 *supra.*

D. THE LONG-STANDING LAW FOR DETERMINING PATENT INFRINGEMENT INCLUDING THE DOCTRINE OF EQUIVALENTS AS LEGISLATIVELY RATIFIED BY THE 1952 PATENT ACT IS SOUND, EQUITABLE AND WORKABLE LAW, AND IT SHOULD NOT NOW BE REJECTED BY THIS COURT

The long-standing law of patent infringement, including the doctrine of equivalents explicated in the 1950 *Graver Tank* case, as legislatively ratified by the 1952 Patent Act, may be summarized as follows:[43]

Point 1. The terms of a patent claim must be construed by reading the claim in the light of the patentee's disclosure and the pertinent prior art.[44]

Point 2. To determine whether the accused device infringes the patent, the accused device is compared with the patentee's device as disclosed in the patent to determine whether both the patented and accused devices are substantially the same in construction, mode of operation, and result.[45]

Point 3. Assuming that the court finds affirmatively as to Point 2 above, "resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it."[46]

Point 4. However, if there is no literal claim infringement according to Point 3 above, the

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[43] For clarity and simplicity of language the discussion in Points 1 to 10 below assumes the patented invention is a device. An analogous approach would be used if the patent relates to a manufacture, composition of matter, or process, see 35 U.S.C. 101.

[44] *Graver Tank, supra,* pages 607-609; *United States* v. *Adams,* 383 U.S. 39, 49 (1966).

[45] *Graver Tank, supra,* at 608.

[46] Id., at 607.

"courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim and hence outside the reach of law. . . . [That] would place the inventor at the mercy of verbalism and would be subordinating substance to form . . ." [47]

Point 5. "The doctrine of equivalents evolved in response to this experience [of Point 4 above]. The essence of the doctrine is that one may not practice a fraud on a patent . . . . 'To . . . prevent an infringer from stealing the benefit of the invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.' " [48]

Point 6. "The doctrine operates not only in favor of the patentee of a pioneer or primary invention, but also for the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results. . . . although the area of equivalence may vary under the circumstances . . ." [49]

[47] Id.

[48] Id., at 608.

[49] Id.

Point 7. "The wholesome realism of this doctrine is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement."[50] That is, the court decides negatively as to Point 2, above.[51]

Point 8. "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case . . . Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was."[52]

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[50] Id., at 608-9.

[51] This reverse application of the doctrine of equivalents prevents a holding of patent infringement when the claims literally cover the accused device but there is no infringement in fact because the accused device is a "different animal" from the patented device. This is one of the most salutary aspects of the doctrine of equivalents as explicated in the 1950 *Graver Tank* case. Yet this has been completely ignored by the AD brief and would be eliminated if the proposals of that brief were adopted by this Court. Further, see Part VI-E hereof below.

[52] *Graver Tank, supra,* 339 U.S. at 609.

Point 9. "A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence."[53]

Point 10. Even though the literal terms of the patent claim are avoided so that infringement is not literal within Point 3 above, if the changes of the accused device which avoid literal infringement are within the doctrine of equivalents according to the above, then the patent is infringed.[54]

Moreover the determination of infringement by applying the doctrine of equivalents according to the *Graver Tank* case (as summarized in Points 1 to 10 above) must be considered in light of the "file wrapper estoppel" rule according to the case of *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126 (1942),[55] and others.[56]

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[53] Id., at 609-10.

[54] Id., page 607-609, and 612.

[55] File wrapper estoppel under *Exhibit Supply* bars recourse to the doctrine of equivalents in cases where the patentee attempts to secure through equivalents what has been rejected by the Patent Office. It prevents application of the doctrine of equivalents to *recapture* coverage which the patentee first sought and then surrendered by amendment in order to obtain the Examiner's assent to his claims.

[56] Among other cases so holding, see *Union Carbide & Carbon Corp.* v. *Graver Tank & Mfg. Co.*, 196 F.2d 103, 107 (7th Cir. 1952); *cert. denied*, 343 U.S. 967 (1952), hereinafter called the "7th Cir. *Graver Tank* 2d case", further discussed below.

When the doctrine of equivalents according to the 1950 *Graver Tank* case is reasonably and intelligently applied subject to (1) the conditions and qualifications stated in *Graver Tank* and (2) the file wrapper estoppel rule of *Exhibit Supply*, the patentee is effectively prevented "from running wild" in attempting to unduly expand his claims and unwarrantedly assert and establish patent infringement. A good example of the practical working of the doctrine of equivalents of the 1950 *Graver Tank* case in conjunction with the file wrapper estoppel rule of *Exhibit Supply* is found in the 7th Cir. *Graver Tank* 2nd case, *supra*. In the latter case, the court delineated the lawful enforceable scope of the very claims held valid and infringed by this Court in the 1950 *Graver Tank* case, and thus reached a conclusion of non-infringement of that same patent with respect to certain modified accused compositions later adopted by the defendant. Many similar example of file wrapper estoppel in conjunction with the doctrine of equivalents as above stated may be found in other cases dealing with patent infringement under the Patent Act of 1952.

Therefore, the present law of patent infringement including the doctrine of equivalents as set forth in the 1950 *Graver Tank* case is sound, equitable, workable patent law. This was legislatively ratified and codified by Congressional enactment of sections 112 and 271(a). Such law is an integral part of the federal statutory patent scheme adopted by the Congress under the 1952 Patent Act, and it implements the policy and goals of the patent system as established by Congress.

E. THE LITERAL CLAIM SYSTEM PROPOSED IN THE AD BRIEF WOULD THWART THE PUBLIC POLICY OF THE PATENT SYSTEM AS EXPRESSED BY THIS COURT.

The ease with which patent claims could be circumvented if narrowly limited to their literal scope presents an important issue of basic patent policy. The AD brief acknowledges the desirability of encouraging *inventing around* legitimate inventions as expressed by previous decisions of this court.[57] Indeed, inventing around existing patents is clearly "contributing to the progress of the useful arts" in the truest sense of the Constitution.[58] However, if the rule of literalism were adopted by this Court there would no longer be any incentive to "invent around" in substance since mere trivial deviations would suffice to avoid the inventions recognized by the grant of patents.

The patent statutes make it mandatory that a patent application be prepared in the early stages of development of an invention,[59] prior to the time that the invention is likely to have received any substantial commercial exposure. The public purpose served by this policy is the creation and early publication of a fund of technological information which may serve as a base for further substantive advances in the useful arts. However, as elsewhere in life, the achievement of this policy has its price, namely, that the patent application and claims must be prepared at a point in

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[57] AD brief, para. bridging pages 16-17.

[58] No doubt this is why the Constitution provides for exclusive rights instead of honors and emoluments. As one astute patent lawyer has observed, "Few laymen seem to understand that it's the monopoly that promotes the progress."

[59] 35 U.S.C. 102(b).

time where neither the inventor nor his attorney know or could know the specific details of all final commercial embodiments. Thus it is that patent applications are prepared and claims are drawn on the basis of what must be classified as imperfect knowledge from a commercial and industrial standpoint.

Considering the other side of the coin, it is common knowledge that the Patent Office has for years been laboring under the burden of a very considerable backlog of pending patent applications. As a result, the time that a Patent Examiner may devote to any given patent application, and particularly to the claims thereof, is strictly limited.[60]

Thus, in the case of an average patent, the specification and claims represent the best efforts of the inventor, attorney, and Patent Examiner on the basis of incomplete commercial knowledge and under cer-

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[60] The total time that a Patent Examiner can devote to a patent application must include the following: (1) A thorough study of the specification and drawings in order to understand the invention, (2) a search through the prior art to discover any pertinent prior patents, (3) a study of such pertinent prior patents to enable the Examiner to understand their operation, (4) a comparison of the disclosures of these patents to the original claims, (5) the preparation of an Office Action usually rejecting at least certain claims over the prior patents for specifically expressed reasons, and (6) consideration of written responses of the inventor. In the average case, two Office Actions are necessary, plus at least one conference with the inventor's attorney. A generous estimate would be that of this total time, the Examiner spends in the order of one-third to one-fourth in detailed consideration of the language of the claims.

tain practical time limitations, particularly as to the claims.[61]

However, if at any time during the seventeen year life of the patent, its claims are tested in infringement litigation, unlimited legal warfare ensues and literally thousands of man hours are devoted to an unbelievably thorough and comprehensive study of and attack upon those same claims. Further, the study of the claims in a patent infringement situation occurs in a markedly different economic environment and against a different factual background. Specifically, the inventive concept has been embodied in a commercial device, has achieved sufficient commercial success to warrant a competitor to copy, and most probably has been commercially presented in multiple embodiments. In short, the invention at that time represents a profit-making business such that the attack upon the claims warrants the expenditure of a hundred-fold more time and money than could conceivably have been mustered or justified by the inventor in fulfilling his bargain of disclosure to the public in exchange for the patent. Under such circumstances, it should be self-evident that it would be literally impossible for even the most brilliant attorney and Patent Examiner to foresee, predict and obviate every facet of alleged

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[61] The total time which an attorney devotes to the preparation of a patent application must encompass: (1) Discussions with the inventor in order to understand the invention, (2) laying out the patent drawings including conferring with the draftsman, (3) drafting and redrafting the specification which provides the detailed technical description of the invention, (4) drafting the claims, (5) studying the prior patents cited by the Examiner, (6) amending the claims and preparing written responses to the Office Actions, and (7) conferring with the Examiner.

claim deficiency or limitation which will be conceived and urged in the commercial onslaught on the patent, *after* it has been commercially proven.

While the AD brief credits patent attorneys with being "certified experts",[62] we of the APLA, representing the entire spectrum of the patent bar, hereby disown the omniscience, prescience, and sheer genius which would be required to cope with the gross inequity and unworkability of the system which is proposed in the AD brief.

Claims are communications of the inventor's intellectual conceptions developed by him after research and experiment. However, words, the outer wrappings used to bundle ideas for delivery to auditors and readers, are often tools for tortured logic. Most claims, like all communications, are open to as many interpretations as the ingenuity of counsel can conjure up. However, practicality of meaning, as embodied in the direct and reverse application of the doctrine of equivalents, steps in and arrests such runaway arguments.

The semantic or virtually semantic approach proposed in the AD brief would eliminate the leaven of practicality and reality provided by this beneficial doctrine.

If attorneys are forced to cope with a semantic or virtually semantic system, it should be evident that there will be a predictable tendency to press for more vague and comprehensive claims as well as an overall increase in the number of claims to be examined. This will in turn create a very large multiplication of Patent

[62] AD brief, page 16, fn. 10.

Office appeals and Patent Office litigation. Under such circumstances, and the present backlog of pending patent applications, the Patent Office could not hope to cope with such an addition to its existing burdens without encountering very serious administrative problems. The same would be true with respect those courts which handle appeals from Patent Office decisions.

It is sound public policy to require inventors and their attorneys to particularly point out and distinctly claim the subject matter which the inventor regards as his invention.[63] We submit that it would be contrary to that public policy to now jettison a doctrine which has been explicated by this Court for one hundred years, particularly as in *Graver Tank,* in favor of a "fundamentally revised"[64] test which would take at least twenty-five years for reasonable delineation.

F. AD BRIEF CONTENTION THAT PASSAGE OF 1890 ANTITRUST LAWS NOW REQUIRES REJECTION OF THE GRAVER TANK CASE AND DOCTRINE OF EQUIVALENTS IS REFUTED BY HISTORY OF ANTITRUST AND PATENT LEGISLATION INCLUDING THE 1952 ACT AND BY DECISIONS OF THIS COURT

The AD brief contends that the long-standing doctrine of equivalents explicated in the 1950 *Graver Tank* case interpreting the 100 year old pertinent statutory patent claim provisions[65] cannot be reconciled with the 1890 passage of the first antitrust laws after the 1853 *Winans* decision on the doctrine of equivalents. It is further contended that the 1890 passage of the federal antitrust laws "added a new dimension"

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[63] See *Graham* v. *John Deere Co.*, 383 U.S. 1, (1966).

[64] AD brief, page 2.

[65] R.S. 4888 readopted in 35 U.S.C. section 112, par. 2 (1952).

now requiring restrictive interpretation of patent claims thereby limiting U. S. patent rights because of "dominant" congressional policy according to the antitrust laws.[66]

All federal antitrust laws are based on the "commerce clause" of Article I, Section 8 of the Constitution which also contains the "patent clause" on which the federal patent laws are based.[67]

Thus, both the patent statutory scheme and the antitrust statutory scheme are established by Congress, to which the Constitution delegates all legislative power with respect to both patent and antitrust laws, under Article I, Section 8.

The patent system adopted by Congress seeks to promote U. S. technical, economic and social progress by granting limited exclusive patent rights in order to encourage (1) early invention disclosures and nonreliance on trade secrets, (2) competition by real innovations instead of copying, and (3) risk capital for commercializing speculative inventions.[68] The

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[66] For such contentions, see AD brief, pp. 12-13 and elsewhere. That the AD brief is historically and legally erroneous in its assertions regarding the pertinent patent statutes and patent claim practice thereunder is shown in Parts VI-C-3 to 5 hereof, pages 12-21, *supra*.

[67] See Constitution, Article I, Section 8, Clause 3 ("Commerce clause") and Clause 8 ("Patent clause").

[68] See "Study No. I" by Vannevar Bush for the Patent Trademark and Copyright Subcommittee of the U. S. Senate Committee on the Judiciary, 84th Cong., 2d Sess. (1956), especially p. 1; also note the following comment attributed to President Franklin D. Roosevelt on the cover of Critique of "Report of the President's Commission on the Patent System" by George N. Robillard: "Patents are the Key to our Technology, Technology is the Key to Production, and Production is the Key to Victory."

statutory patent scheme established by Congress is as much as part of the overall federal policy regarding competition as is the antitrust law.

It is Congress which decides and establishes the national policy and statutory schemes for appropriate balance between the federal patent and antitrust laws. Congress did so when it passed the 1952 Patent Act; that is recognized in this Court's 1964 decision in the *"Aro II"* case, *supra.*

Since at least 1912, this Court has frequently considered and ruled on the interrelationship of the federal patent and antitrust statutes and the resultant effect on the limited exclusive rights granted under U. S. patents. In a long line of cases, beginning with the 1912 *Dick* case[69] and 1917 *Motion Picture* case[70] and continuing to the 1944 *"Mercoid* cases,"[71] this Court rendered numerous decisions on the enforceable scope and limitations of patent rights in light of the involved patent claims and various accused commercial activities. That is established by merely reading the majority opinion in the *"Mercoid* I" case which cites and reviews dozens of court decisions from 1890 to 1944 regarding the relationship between federal patent and antitrust policy and laws and the resultant effect on U. S. patent rights.

Five of the nine Justices of this Court participating in the 1944 *"Mercoid* cases" also participated in the

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[69] *Henry* v. *Dick Co.*, 224 U.S. 1 (1912).

[70] *Motion Picture Patents Co.* v. *Universal Film Mfg. Co.*, 243 U.S. 502 (1917).

[71] *"Mercoid Corp.* v. *Mid-Continent Invest. Co.*, 320 U.S. 661 (1944) [called "Mercoid I"]; and simultaneously decided *"Mercoid Corp.* v. *Minneapolis-Honeywell Reg. Co.*, 320 U.S. 680 (1944) [called "Mercoid II"].

1950 *Graver Tank* case. Hence, it is unreasonable to conclude that when this Court rendered the *Graver Tank* decision the Court was unaware of the relationship and balance of patent and antitrust laws which was discussed in such detail in the *Mercoid* cases.

More significantly, as held by this Court in the 1964 *Aro II* case, *supra*, the statutory terms of 35 U.S.C. sections 271(c) and (d) and their legislative history show that Congress overruled the 1944 "*Mercoid* cases" and like pre-1952 patent misuse and corollary antitrust decisions to the extent they are inconsistent with sections 271(c) and (d) of the 1952 Patent Act. In view of detailed consideration of the "*Mercoid*" and similar pre-1952 cases in Congressional proceedings resulting in enactment of new section 271 of the 1952 Act, and the clearly indicated intent of Congress, it is unreasonable to conclude that in passing the 1952 Patent Act, Congress did not consider and decide on the relationship and balance between the federal policies and statutory schemes for both patent and antitrust laws.

By its 1952 enactment of new section 271 and readoption of former R.S. 4888 in the second paragraph of section 112, Congress has spoken on these points against the proposals urged in the AD brief. That should be the end of it since the Constitution delegates to Congress all legislative powers on federal patent and antitrust policies and the statutory schemes to implement them. Hence, the AD brief contention that passage of the first federal antitrust law in 1890 now requires reversal of the 1950 *Graver Tank* case is without merit.

G. CONGRESS HAS SPOKEN IN THE 1952 ACT AND ANY REVISIONARY LEGISLATION SHOULD COME FROM THAT SOURCE UNDER THIS COURT'S ESTABLISHED POLICY

This Court has repeatedly held that it cannot ignore the plain import of a Congressional enactment which has been deliberately drafted after extended considerations by the Congress;[72] and that contentions that Congress could or should have adopted other statutory schemes are matters of policy which rest entirely with the Congress and not with the courts.[73] This Court has refused repeatedly to judicially legislate changes in the law on the grounds of economic, social or other policy when Congress has spoken on the subject by enactment of appropriate legislation. Under the system of government created by our Constitution it is up to the Congress, and not the courts, to decide on the wisdom and utility of such legislation.[74] This is particularly applicable where the Congress is given broad and sweeping powers as in the case of patents under the pertinent provisions of Article I quoted *supra*.[75]

The gravamen of the AD brief is to request this Court to judicially legislate out of existence the doctrine of equivalents as set out in the *Graver Tank* case of 1950, the *Sanitary Refrigerator* case of 1929 and even earlier decisions of this Court applying R.S. 4888, readopted in section 112 of the Act of 1952. This request in the AD brief is founded on an apparent notion that the doctrine of equivalents, in some un-

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[72] *Sinclair Refining Co.* v. *Atkinson*, 370 U.S. 195, 215 (1962).

[73] Ibid. See also, *Heart of Atlanta Motel, Inc.* v. *United States*, 379 U.S. 241, 261-262 (1964).

[74] *Joseph E. Seagram & Sons* v. *Hostetter*, 384 U.S. 35, 47 (1966).

[75] *Graham* v. *John Deere Co., supra*, 383 U.S. at 6.

specified manner hinders technological progress and discourages commercial enterprise. Thus, the AD brief includes statements concerning the doctrine of equivalents such as the following:

"hindering . . . creative enterprise," page 2;

"hinders . . . technological progress," page 3;

"importance of the issue to the national economy," page 3;

"discourages inventive efforts and commercial enterprises," page 5;

"confers economic advantage on the patentee," page 5;

"economic impact tends to undermine the paramount public interest in competitive technological advancement," page 13;

"prevent competitors seeking to invent around" page 14;

"reaches into the area renounced to the public," page 15; and

"reaches into the public domain," page 15.

We are aware of no factual evidence of record (or legal authority) to support the above statements. The facts available to the Court in this case are those developed by private litigants concerned primarily with a specific agreement pertaining to particular patents.

Since 1967 there has been and now is pending before the Congress a complete codification and revision of the U.S. patent laws based on consideration in depth of the statutory patent scheme and other factors under-

lying federal patent policy including recommendations of the President's Commission on the Patent System appointed in 1965.[76] This Court should direct the Anti-trust Division to the Congress as the appropriate forum for reversing long-standing law legislatively ratified by the Congress in the 1952 Act, instead of seeking judicial legislation from this Court radically altering the statutory patent scheme established by the Congress in 1952 after four years' thorough consideration.

Aside from the viewpoints of Constitutional law, the broad scope of the congressional power to legislate on patents, and this Court's policy not to so legislate, we further submit that the doctrine of equivalents should be retained on the merits because it is good law. The rules of patent infringement according to *Graver Tank* and other similar cases legislatively ratified by congressional enactment of the 1952 Act provide solid and equitable rules fairly balancing the interests of patentees and their competitors. These rules enable those persons to determine infringing or noninfringing activities with reasonable certainty to thereby help achieve the technical, economic, social and other goals of progress of the federal patent system.

VII. CONCLUSION

It is urged that this Court reject the proposals of the AD brief and refuse to reject the doctrine of equivalents as explicated in the *Graver Tank* case and refuse

[76] See page 7, *supra*, and fn. 9, *supra*, wherein this Court took judicial notice of such pending legislation and recommendations of the Presidents Commission in *Graham v. John Deere Co.*, *supra*.

to substitute the "fundamentally revised" standard proposed by the Antitrust Division.

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